

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Edward O. Clapper Examiner: Cam Y. T. Truong
Serial No.: 10/020,483 Group Art Unit: 2162
Filed: December 12, 2001 Docket: 884.611US1
Title: SYLLABIC SEARCH ENGINES AND RELATED METHODS (As Amended)
Customer No. 21186

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed July 14, 2006, the Applicant requests review of the final rejection in the above-identified application.

No amendments are being filed with this request. A response to the Final Office Action was previously filed with the U.S. Patent Office on November 14, 2006 with the appropriate extension of time.

This request is being filed with a Notice of Appeal.

This request is also being filed with a Petition, as well as the appropriate fee, to obtain a three-month extension of the period for responding to the Office action, thereby moving the deadline for response from October 14, 2007 to November 14, 2007. Since January 14, 2007 falls on a Sunday, it is believed that the due date carries over to the next day, Tuesday, January 16, 2007 (Monday, January 15, 2007 is a federal holiday).

The review is requested for the reason stated below.

There is clear error in the §103 rejection. The two references (Funaki, U.S. 6,689,946; Berke, U.S. 6,629,094) used to reject the independent claims do not teach, describe, or suggest the following limitation, which is recited in each of independent claims 5, 13, 20, and 27:

“receiving a search string including an ordered sequence of syllable counts”

Thus, a *prima facie* case of obviousness has not been established, and the rejection of independent claims 5, 13, 20, and 27 under §103 should be reversed.

§103 Rejection of the Independent Claims

Independent claims 5, 13, 20, and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki (U.S. 6,689,946) in view of Berke (U.S. 6,629,094).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Funaki in view of Berke fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established. For example, as discussed below, neither Funaki nor Berke disclose “receiving a search string including an ordered sequence of syllable counts”.

Applicant’s FIG. 5 depicts an example of a “syllable sequence” 404, such as the syllable sequence 1, 1, 3, 1, 1, 2, 1, 1, 2. In each of Applicant’s independent claims 5, 13, 20, and 27, an “ordered sequence of syllable counts” is compared with the contents of a database of analyzed documents. This is not shown anywhere in Funaki or Berke.

Funaki receives only a number of syllables – not an “ordered sequence of syllable counts”, as recited in each of Applicant’s independent claims 5, 13, 20, and 27.

From a careful reading of Funaki as a whole, it appears to contain no disclosure whatsoever about “receiving a search string including an ordered sequence of syllable counts”. To the contrary, Funaki describes and employs only “number of syllables” (col. 8, lines 7 and 35); “syllable number count” (col. 8, line 36); “counted number of syllables” (col. 8, lines 37-38); “two-syllable word” (col. 8, line 41); etc. Funaki only shows a syllable count and a part of speech being compared with words registered in the dictionary J, whereas in Applicant’s independent claims 5, 13, 20, and 27 an “ordered sequence of syllable counts” (e.g., 1, 1, 3, 1, 1, 2, 1, 1, 2, as one example, described beginning at page 9, line 30 of Applicant’s written description) is compared with the contents of a database of analyzed documents. These are very different operations.

Similarly, a careful reading of Berke provides no disclosure whatsoever about “receiving a search string including an ordered sequence of syllable counts”.

In the Advisory Action dated December 4, 2006, the Office stated:

“Funaki teaches a word ‘beautiful’ has three syllables. This word is counted following order sequence syllables as shown in figs. 11-12.”

Funaki’s FIG. 11 depicts an example search result list. It may show several words and their meaning (refer to col. 9, lines 36-58). However, nowhere do FIG. 11 and its accompanying text disclose “an ordered sequence of syllable counts”.

Funaki’s FIG. 12 depicts another example search result list, including several words, their corresponding part of speech, and their corresponding number of syllables (refer to col. 9, lines 59-64). The Office’s specific argument regarding FIG. 12 is not understood. In any event, nowhere does FIG. 12 show “a search string including an ordered sequence of syllable counts”.

Reservation of Rights

To simplify the issues in this Pre-Appeal Brief Request for Review, Applicant has omitted additional arguments regarding the Office’s rejection of the independent claims, and Applicant has omitted arguments regarding the Office’s rejection of the dependent claims, but Applicant reserves the right to present such arguments in Applicant’s Appeal Brief should it become necessary to do so.

CONCLUSION

Reconsideration and withdrawal of the rejection of claims 5-30 under §103 as a result of this Pre-Appeal Brief Request for Review is respectfully requested. Since no *prima facie* case of obviousness has been established with respect to the rejected claims, the Applicant respectfully submits that all claims are allowable, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant’s attorney Ann M. McCrackin (located in Minneapolis, Minnesota) at (612) 349-9592 or Applicant’s below-signed attorney (located in Phoenix, Arizona) to discuss any questions that may remain with respect to the present application.

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Page 4
Dkt: 884.611US1

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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